

### REMARKS

Claims 7, 9, and 12 have been amended. Claims 7, 9, and 12-13 are now pending in this application. Support for the amendments is found in the existing claims and the specification as discussed below. Accordingly, the amendments do not constitute the addition of new matter. Applicant respectfully requests the entry of the amendments and reconsideration of the application in view of the amendments and the following remarks.

#### Priority

The Examiner has acknowledged the claim for foreign priority and receipt of the priority documents. It is not necessary to submit an English translation at this stage as there is no intervening reference. The Rule 41 sections cited by the Examiner in the Office Action relate to contested cases and interferences. Should there be any indication that an interference might be declared, Applicants will submit a certified English translation of the Japanese priority document.

#### Rejection under 35 U.S.C. § 103(a)

Claims 7-9 and 12-13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ishida, et al. (EP 1147764).

Claim 7 has been amended to a preferred embodiment (Centaureidin) which is not taught by Ishida, et al. Support is found in the specification as filed and specifically in cancelled claim 8. The amendment is responsive to the Examiner's second point on page 4 of the Office Action. As the amendment limits the claims to a preferred embodiment which has been previously searched, entry and consideration of the amendment after final is respectfully requested.

The Examiner states that it is not clear which individuals are encompassed by the limitation "individuals in need for inhibition of melanocytic dendrites" (1<sup>st</sup> point on page 4 of Office Action). In response, Applicants' present the Declaration of Akihiro Tada, one of the inventors of the present application (hereafter TADA Declaration). In the TADA Declaration, a compound (Nobiletin) corresponding to Formula (III) of Ishida which corresponds to general Formula (I) of Ishida, et al. is compared to Centaureidin of the presently claimed invention.

As can be seen from item 7 in the TADA Declaration, the formulation corresponding to Ishida, et al. (Nobiletin) does not inhibit dendrite length. Measurements are comparable to the control. In contrast, Centaureidin significantly inhibits dendrite length (30 +/-10  $\mu$ m).

As discussed in the previous response, the claimed method is directed to the treatment of a different condition than disclosed by Ishida, et al. Ishida, et al. is directed to treatment of conditions caused by melanin overproduction. As discussed in the Background section of the present specification, some forms of dyschromatosis cannot be effectively treated by inhibitors of melanin production (see present specification, page 1, last line to page 2, line 13). Applicants' claimed invention is directed to treatment of conditions caused by elongation of melanocytic dendrites. While both treatments relate to skin, the two treatments are not interchangeable as some skin conditions result from elongation of melanocytic dendrites rather than melanin production.

Furthermore, all of the claims are now limited to centaureidin. The compounds of Ishida, et al. have an effect opposite to the effects of centaureidin. Namely, the compounds of Ishida, et al. inhibit melanin production while centaureidin has negligible effect on melanin production as discussed in the previous response with respect to Tada, et al. (Tada, et al. IFSCC Magazine, presented at 23<sup>rd</sup> IFSCC Congress 2004, Orlando FL; Attachment B to response of 10/28/08, hereafter TADA reference). Centaureidin clearly has different properties than the compounds of Table 1 on page 8 of Ishida, et al. While the compounds of Ishida, et al. inhibit melanin production, Centaureidin does not appreciably inhibit melanin production.

Accordingly, the compound of the claimed method, Centaureidin, is non-obvious over the compounds of Ishida, et al. which have a different action than Centaureidin. The compounds of Ishida, et al. inhibit melanin production but do not inhibit dendrite elongation as shown by the TADA Declaration. Centaureidin of the claimed invention inhibits dendrite elongation but does not have appreciable effect on melanin production as shown by the previously submitted TADA reference.

Application of the method of Ishida, et al, in which inhibitors of melanin production are applied to skin, would not be satisfactory for treatment of forms of dyschromatosis in which inhibitors of melanin production are not satisfactorily effective. An "individual in need" of a

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skin treatment to inhibit elongation of melanocytic dendrites would not be effectively treated with the compounds disclosed by Ishida, et al.

In view of Applicants' amendments, arguments and the TADA Declaration, reconsideration and withdrawal of the above ground of rejection is respectfully requested.

#### **No Disclaimers or Disavowals**

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicant is not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicant reserves the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicant has made any disclaimers or disavowals of any subject matter supported by the present application.

#### **CONCLUSION**

In view of Applicants' amendments to the claims and the foregoing Remarks, it is respectfully submitted that the present application is in condition for allowance. Should the Examiner have any remaining concerns which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.


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Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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